Claims 1 through 3, 10, 12 through 16, 22, and 24 were rejected under §102(e) as anticipated by the Daniels reference[1]. Claims 5, 11, 18, and 23 were rejected under §103 as unpatentable over the Daniels reference in view of the Richardson et al. reference[2]. Claims 6 and 19 were rejected under §103 as unpatentable over the Daniels reference in view of the Lemilainen et al. reference[3]. Claims 7 through 9, 20, and 21 were rejected under §103 as unpatentable over the Daniels reference in view of the MacAuley et al. reference[4]. And claims 4 and 17 were rejected under §103 as unpatentable over the Daniels reference in view of Official Notice taken by the Examiner. As such, all of the claims in this application are subject to a prior art rejection involving the Daniels reference, such rejection in each case using the Daniels reference as the primary reference.

Applicants previously traversed the rejection, on the grounds that the Daniels reference was not prior art against the claims in this case. The Examiner responded, in the Office Action of July 5, by asserting that the Daniels reference claims priority to a provisional application filed September 22, 1998, and by asserting that, on the Examiner's review, "subject matter pertaining to Daniels was found, for example, on pages 5, 13-14, 20, 24, and figs. 3C, 24, 28, 39 of the provisional application".[5] The Examiner did not provide a copy of the provisional application for review by Applicants, nor is one available via Public PAIR. Based on these assertions, the Examiner maintained the rejection of the claims as stated above, and made the rejection final.

Applicants again respectfully traverse the final rejection of claims 1 through 24 in this case, on the grounds that the Daniels reference is not prior art against the claims in this case under any subsection of §102. Applicants wish to further clarify their arguments in this regard.

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[1] U.S. Patent Application Publication US 2003/0074672 A1, published April 17, 2003 based on application S.N. 10/253,012 filed December 11, 2002.
[2] U.S. Patent No. 6,028,764, issued February 22, 2000 to Richardson et al.
[3] U.S. Patent No. 6,681,239 B1, issued January 20, 2004 to Lemilainen et al.
[4] U.S. Patent No. 6,663,560 B2, issued December 16, 2003 to MacAuley et al.
[5] Office Action of July 5, 2006, page 2.

The "old" version of §102(e) applies to the Daniels reference

This application was filed on March 9, 2001, claiming priority to Provisional Application No. 60/191,287, filed March 21, 2000. Applicants submit that the claims in this case are supported by that provisional application. Therefore, Applicants submit that, under the provisions of §119(e), this application has an effective filing date of March 21, 2000.[6]

As previously argued, the Daniels reference appears to claim priority, as a continuation-in-part, to prior application S.N. 09/886,695 filed June 22, 2001, which in turn claims priority, as a continuation-in-part, to prior application S.N. 09/787.683 filed March 21, 2001. Both of these prior U.S. applications have filing dates that are after the filing date in this case. Therefore, to the extent that the Daniels reference has an effective filing date limited to either of these two prior applications, the Daniels reference cannot be prior art to the claims in this application.

Applicants comprehend, from the 2002 amendments to §102(e), that the new version of §102(e) applies to applications pending on or filed after November 29, 2000, and therefore applies to their application (*i.e.,* this application).[7] However, those 2002 amendments of §102(e) also state that patents and published applications resulting from an international application filed before November 29, 2000 shall not be effective as prior art as of the filing date of the international application, but rather, are effective as prior art in accordance with §102(e) as in effect on November 28, 2000 (*i.e.,* the previous version of §102(e)).[8]

The Daniels reference is a published application under §122(b). Furthermore, this published application clearly is resulting from an international application filed before November 29, 2000, namely International Application No. PCT/US99/21900.[9] Therefore, under the 2002

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[6] 35 U.S.C. §119(e).
[7] 21ST CENTURY DEPARTMENT OF JUSTICE APPROPRIATIONS AUTHORIZATION ACT, Pub. L. 107-273, §13205 (3).
[8] *Id.* ("Patents resulting from an international application filed before November 29, 2000 and applications published pursuant to section 122(b) or Article 21(2) of the treaty defined in section 351(a) resulting from an international application filed before November 29, 2000 shall not be effective as prior art as of the filing date of the international application; however, such patents shall be effective as prior art in accordance with section 102(e) in effect on November 28, 2000.")
[9] Assuming, *arguendo*, that the Daniels reference is entitled to priority of that international application, which has not been established.

amendments to §102(e), the Daniels reference is effective as prior art, under §102(e), only if it meets the terms of the prior version of §102(e).

As a reminder, the version of §102(e) in force on November 28, 2000 reads:

> A person shall be entitled to a patent unless . . . (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent. . . [10]

However, the Daniels reference is not a *patent*. It is a patent application published under §122(b) and, according to the Public PAIR system as of today, the application corresponding to the Daniels reference has not yet issued as a patent. Only *granted patents* are available as prior art under §102(e) in effect on November 28, 2000. Because the Daniels reference is not a granted patent, it is not a prior art reference under §102(e) against the claims in this application.

The Examiner asserts that the Daniels reference claims priority to a provisional U.S. application filed September 22, 1998. This may in fact be the case.[11] However, the 2002 amendments to §1029(e) are clear on their face — published applications "*resulting from* an international application filed before November 29, 2000 shall not be effective as prior art as of the filing date of the international application; however, such patents shall be effective as prior art in accordance with section 102(e) in effect on November 28, 2000".[12] Regardless of the priority that such an international application may itself have to a previous provisional application, the statute, by its express words, still excludes the new version of §102(e) from applying to that published application.

For this reason, Applicants submit that the Daniels reference is not prior art under §102(e) because it is not a patent.

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[10] 35 U.S.C. §102(e), in effect on November 28, 2000.
[11] Applicants do not admit that such priority attaches, as discussed below.
[12] Pub. L. 107-273, *supra.*

The Examiner has failed to establish that the provisional filing claimed by the Daniels reference has prior art effect

Alternatively, Applicants traverse the prior art rejection of the claims in this case to the extent based on the Examiner's assertion that the provisional application, to which priority is claimed by the Daniels reference, establishes the Daniels reference as prior art.

First, Applicants traverse the rejection on the grounds that the standard asserted by the Examiner as establishing the effect of the Daniels provisional application is not met by the Examiner's own statements in the Office Action. The Examiner asserts that "MPEP Chapter 2136.03(IV) states that the parent filing date can be used if the parent supports the claims of its child".[13] Assuming *arguendo* that this is the proper legal test, the Examiner's own assertion fails to meet this test. Rather, the Examiner merely asserts:

> The provisional has been reviewed and subject matter pertaining to Daniels was found, for example, on pages 5, 13-14, 20, 24, and figs 3C, 24, 28, 29 of the provisional application.[14]

The assertion that "subject matter pertaining to Daniels" was found in the provisional application is far short of a finding that claims in the Daniels reference are supported by the provisional application. Accordingly, by the Examiner's own terms, insufficient factual basis is presented in the Office Action to sustain the rejection.

As an aside, the Examiner did not provide a copy of the Daniels provisional application to Applicants, nor is that provisional application available via the PAIR system. Applicants therefore do not have a fair chance, or in fact any chance, to review the Daniels provisional application and respond to the Examiner's assertion. Withdrawal of the rejection, or at a minimum a resetting of the statutory time for response, is therefore requested for this reason alone.

Secondly, however, Applicants submit that, even if the Daniels reference is available under §102(e), it does not enjoy the effect of its provisional filing unless at least one claim in the

[13] Office Action, *supra*, page 2.
[14] *Id.*

Daniels reference is supported by the provisional application,[15] *and* unless the provisional application itself properly supports the subject matter relied upon to make the rejection, in compliance with 35 U.S.C. §112, ¶1.[16]

Neither finding is present in this case. As noted above, the Examiner failed to establish that the Daniels reference enjoys the effective filing date of the provisional application, because there is no finding that any claim in the Daniels reference is supported by the provisional filing. Without such a finding, the Daniels provisional application has no more relationship to the Daniels reference than any other provisional application filed by any other applicant. Furthermore, the Examiner makes no assertion that the Daniels provisional application includes the very subject matter relied upon to make the rejection. As such, the rejection is currently based on the teachings of the Daniels reference as published,[17] with no proof whatsoever that those alleged anticipating teachings were known by Daniels prior to Applicants' filing date.[18]

For these reasons, Applicant submit that the final rejection in this case, as based on the Daniels reference with priority to its provisional filing, is in error because there is an insufficient finding that the subject matter relied upon to make the rejection has a date prior to the filing date of this case.

In conclusion

For the foregoing reasons, Applicants submit that the Daniels reference is not prior art against this application. Because each basis of rejection presented against the claims includes application of the Daniels reference, either individually or in combination with other references, Applicants submit that the final rejection of the claims in this case is in error. Applicants therefore respectfully traverse the §102(e) and §103 rejections of the claims in this case, and request reconsideration.

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[15] 35 U.S.C. §119(e).
[16] MPEP § 706.02(f)(1).
[17] Which has dates after the effective filing date of this application, as previously argued.
[18] Much less statutorily available as prior art.

For these reasons, Applicants respectfully submit that all claims in this case are in condition for allowance. Reconsideration of this application is requested.

Respectfully submitted,
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